

Remarks

This Amendment is responsive to the Office Action mailed May 5, 2005. The amendments and remarks are proper, do not introduce new matter, do not require additional searching, are not narrowing in view of a prior art rejection, and obviate all rejections so as to place the application in proper condition for allowance of all pending claims.

Rejection Under 35 USC 102(b)

Claim 14 was again rejected as being anticipated by Walpin '993 and Tarquinio '253. The Applicant reiterates that neither of these references can properly sustain the rejection of claim 14, because neither of them discloses structure that is capable of the identical function of the *means for constraining* element. As Applicant argued before, the nodulated cover 30 of Walpin '993 is inherently incapable of providing contiguous supporting contact, and is expressly defined as being outside the meaning of the *means for constraining* element. (See Applicant's Amendment of 1/31/05, ppg. 7-8) Also as argued before, Tarquinio '253 is inherently incapable of supporting the upper body in a partially reclined position. (See Applicant's Amendment of 1/31/2005, ppg. 9-10).

Nevertheless, the Applicant has canceled claim 14 and the claims depending therefrom without prejudice solely for the purpose of simplifying the unresolved issues in order to facilitate prosecution on the merits to allowance or appeal. The cancellation of these claims obviates the present rejection under Section 102.

Rejection Under 35 USC 103

Claims 1, 2, 4-6, 18, and 20 were rejected as being unpatentable over Tarquinio '253 in view of Robinson '575. This rejection is respectfully traversed.

Claim 1

The Examiner has failed to make the requisite prima facie case of obviousness by not providing a bona fide motivation or suggestion to combine and modify the cited references to arrive at the present embodiments as claimed. The proper question under Section 103 is not whether differences themselves would have been obvious, but rather whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The claimed embodiments as a whole require both that the base have an ILD that is greater than 40 and that the cover have an ILD that is less than the base.

Applicant agrees with the Examiner that Tarquinio '253 is deficient regarding teaching a base with an ILD greater than 40. The Examiner attempts to cure that deficiency by combining the teaching of Tarquinio '253 with that of Robinson '575, which discloses the base having an ILD of 24 to 50. However, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir. 1983). Robinson '575 also teaches a cover with an ILD that is greater than the base by being within the contemplated ILD range for the cover of 12 to 45. That is, Robinson '575 considered in its entirety teaches a base with an ILD as low as 24 and a cover with an ILD as high as 45.

There is no express motivation from the references themselves to combine them because they are contradictory. That is, Robinson as a whole '575 teaches the cover having an ILD that is greater than the base, but Tarquinio '253 teaches the cover having an ILD that is less than the base. Accordingly, the only motivation to combine the references as the Examiner suggests comes from knowledge of the Applicant's present disclosure which is improper hindsight reasoning.

The Examiner alleges the requisite motivation as: "It would have been obvious to

have the ILD ratio greater than 40 as taught by Robinson in order to render the overall mattress of Tarquinio somewhat firmer.” (Office Action of 5/5/2005, pg. 3) In essence, the Examiner is implying that one skilled in the art would increase the ILD in Tarquinio ‘253 from 32 (what it teaches) to greater than 40 (what is claimed) to obtain a firmer mattress. However, a statement that modifications of the prior art to meet the claimed invention would have been within the knowledge of a skilled artisan because all aspects of the claimed invention are individually taught by different references is not sufficient to substantiate the motivation or suggestion required by a bona fide prima facie case of obviousness. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999); MPEP 2143.01.

The rejected claim recites both a base with an ILD greater than 40 and a cover with an ILD less than the base. The cited references cannot sustain the Section 103 rejection because the Examiner has failed to substantiate the requisite motivation or suggestion to the skilled artisan to modify and combine the cited references to arrive at the present embodiments as claimed. Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested.

Rejection Under 35 USC 103

Claims 1-3 and 5-6 were rejected as being unpatentable over Walpin ‘993 in view of Robinson ‘575. This rejection is respectfully traversed.

Claim 1

The Examiner has failed to make the requisite prima facie case of obviousness by not providing a bona fide motivation or suggestion to combine and modify the cited references to

arrive at the present embodiments as claimed. The proper question under Section 103 is not whether differences themselves would have been obvious, but rather whether the claimed invention as a whole would have been obvious. *Stratoflex* The claimed embodiments as a whole require both that the base have an ILD greater than 40 and the cover have an ILD less than the base.

Applicant agrees with the Examiner that Walpin '993 is deficient regarding teaching a cover having an ILD that is less than the base ILD. The Examiner attempts to cure that deficiency by combining the teaching of Walpin '993 with that of Robinson '575, which discloses the base having an ILD of 24 to 50. The Examiner asserts Robinson '575 as teaching the cover having an ILD that is less than the base. However, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore* Robinson '575 also teaches a cover with an ILD that is greater than the base by being within the contemplated range of 12 to 45. That is, Robinson '575 considered in its entirety teaches a base with an ILD as low as 24 and a cover with an ILD as high as 45. Accordingly, the Applicant respectfully traverses the Examiner's reading of Robinson '575 as misplaced.

Also, there is no express motivation from the references themselves to combine them because they are contradictory. That is, Robinson as a whole '575 teaches the cover having an ILD that is greater than the base, but Tarquinio '253 teaches the cover having an ILD that is less than the base. Accordingly, the only motivation to combine the references as the Examiner suggests comes from knowledge of the Applicant's present disclosure, which is improper hindsight reasoning.

The Examiner alleges the requisite motivation as: "It would have been obvious to have the ILD ratio of the base greater than the cover as taught by Robinson in order to render

the overall mattress of Walpin somewhat firmer while providing minimum body pressure.” (Office Action of 5/5/2005, ppg. 4-5) In essence, the Examiner is implying that one skilled in the art would increase the ILD in Walpin ‘993 from what it teaches to what is claimed to obtain a firmer mattress. However, a statement that modifications of the prior art to meet the claimed invention would have been within the knowledge of a skilled artisan because all aspects of the claimed invention are individually taught by different references is not sufficient to establish the motivation or suggestion required to substantiate a bona fide prima facie case of obviousness. *Ex parte Levengood*; *In re Kotzab*; *Al-Site*; MPEP 2143.01.

The rejected claim recites both a base with an ILD greater than 40 and a cover with an ILD less than the base. The cited references cannot sustain the Section 103 rejection because the Examiner has failed to substantiate the requisite motivation or suggestion to the skilled artisan to modify and combine the cited references to arrive at the present embodiments as claimed. Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested.

Rejection Under Section 103

Claims 7-10, 15-17, and 20 were rejected as being unpatentable over Walpin ‘993 in view of Tarquinio ‘253. This rejection is respectfully traversed.

Claim 7

The Examiner has failed to make the requisite prima facie case of obviousness by not providing a bona fide motivation or suggestion to combine and modify the cited references to arrive at the present embodiments as claimed. The proper question under Section 103 is not whether differences themselves would have been obvious, but rather whether the claimed invention as a whole would have been obvious. *Stratoflex* The claimed embodiments as a

whole require both that the base have an inclined surface and that the cover covering the inclined surface comprise a viscoelastic material.

Applicant agrees with the Examiner that Walpin '993 is deficient regarding teaching a cover comprising a viscoelastic material. The Examiner attempts to cure that deficiency by combining the teaching of Walpin '993 with that of Tarquinio '253, which discloses a non-inclined base having a viscoelastic cover. However, there is no motivation or suggestion where it would render the prior art invention unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) Applicant reiterates from its previous response that the proposed combination of references defeats the intended purpose of Walpin '993. Particularly, Walpin '993 teaches a convoluted surface for the purpose of providing an alternating contacting engagement of skin pressure and air circulation. The suggested replacing of the nodulated foam in Walpin '993 with the elastomeric material of Tarquinio '253 eliminates the air circulation passages, and thus defeats the purpose of Walpin '993's nodulated surface. Accordingly, the only motivation to combine the references as the Examiner suggests comes from knowledge of the Applicant's present disclosure, which is improper hindsight reasoning.

The Examiner alleges the requisite motivation as: "It would have been obvious to one having ordinary skill in the art at the time of the invention to have a cover of visco-elastic foam material as taught by Tarquinio in order to provide reduced compression of the mattress when a weight is placed on the upper surface of the cushion." (Office Action of 5/5/2005, pg. 6) In essence, the Examiner is implying that one skilled in the art would change the cover in Walpin '993 from nodulated foam (what it teaches) to elastomeric material (what is claimed) to obtain a firmer mattress. However, a statement that modifications of the prior art to meet the claimed invention would have been within the knowledge of a skilled artisan because all

aspects of the claimed invention are individually taught by different references is not sufficient to establish the motivation or suggestion required to substantiate a bona fide prima facie case of obviousness. *Ex parte Levengood; In re Kotzab; Al-Site*; MPEP 2143.01.

The rejected claim recites both a base with an inclined surface and a cover on the inclined surface comprising an elastomeric material. The cited references cannot sustain the Section 103 rejection because the Examiner has failed to substantiate the requisite motivation or suggestion to the skilled artisan to modify and combine the cited references to arrive at the present embodiments as claimed. Reconsideration and withdrawal of the present rejection of claim 7 and the claims depending therefrom are respectfully requested.

Rejection Under Section 103

Claims 11-13 were rejected as being unpatentable over Walpin '993 in view of Tarquinio '253 and further in view of Robinson '575. This rejection is respectfully traversed because these claims are allowable as depending from an allowable independent claim, for reasons above, and providing additional limitations thereto. Reconsideration and withdrawal of the present rejection are respectfully requested.

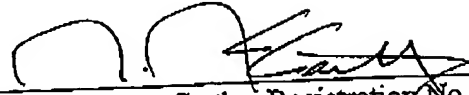
Conclusion

This is a complete response to the Office Action mailed May 5, 2005. The Applicant has submitted herewith a request for telephone interview, the time of which is to be determined by the Examiner and his Supervisor, if after considering this Amendment there are any issues preventing allowance of all pending claims, but before issuing the next action on the merits. The Applicant regrets that the Examiner did not grant the previously requested interview, and believes the requested interview could likely have facilitated more expedient progress on the

merits in this case.

Respectfully submitted,

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